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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,414	12/16/2005	Masao Yamada	1503.73148	1680
24978 GREER, BUR	7590 08/18/200 NS & CRAIN	8	EXAM	IINER
300 S WACKER DR			HALPERN, MARK	
25TH FLOOR CHICAGO, II			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			08/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Application No. Applicant(s) 10/537,414 YAMADA, MASAO Office Action Summary Examiner Art Unit Mark Halpern 1791 -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS. WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filed on 21 July 2008. 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1-52 is/are pending in the application. 4a) Of the above claim(s) 6-48 and 52 is/are withdrawn from consideration. 5) Claim(s) \_\_\_\_\_ is/are allowed. 6) Claim(s) 1-5,49-51 is/are rejected. 7) Claim(s) \_\_\_\_\_ is/are objected to. 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are; a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some \* c) None of: Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). \* See the attached detailed Office action for a list of the certified copies not received. Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

Paper No(s)/Mail Date 6/2/05,8/30/06,6/17/08.

Interview Summary (PTO-413)
Paper No(s)/Mail Date.

6) Other:

Notice of Informal Patent Application

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### DETAILED ACTION

 Applicant's election without traverse of invention I, drawn on claims 1-5, 49-51, in the reply filed on 7/21/2008 is acknowledged.

Claims 6-48, 52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected election, there being no allowable generic or linking claim.

#### Information Disclosure Statement

2) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

All prior art references recited in the Specification (as, for example, recited on Pages 2-4) are to be listed on form PTO-1449 and copies of foreign references are to be provided for review.

#### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3) Claims 1-5, 49-51, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 phrase "no waste liquid may be caused even when compressing the disintegrated fibers" is not clear.

Claim 1 phrase "even when compressing" is conditional which renders the claim indefinite.

Claim 2 phrase "disintegrates the waste paper at a yield of 100 percent" is not clear.

Claim 3 phrase "a predetermined additive" is vague and not clear.

Claim 3 phrase "a specific characteristic" is vague and not clear.

Claim 5 phrase "colors the fibers in a predetermined color" is vague and not clear.

Claim 49 phrase "culture soil" is not clear.

Claim 51 phrase "culture soil" is not clear.

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## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

 Claims 1-5, 49, 51, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura (JP 11-293578).

Claims 1: Kimura discloses a system for disintegrating a waste paper stock in a dry condition by supplying a water mist content of 8-12% of water (Abstract, entire document and figure). It would have been obvious to one skilled in the art at the time the invention was made that the small amount of water mist used is an amount of water within a range such that a liquid waste would not be produced even when the disintegrated fibers are compressed.

Claims 2, 4, 5: the amount of water to be added is a matter to be appropriate optimized during the system operation. Addition of an adhesive agent, filler and coloring of a fiber material are additions of components regularly used for manufacturing of paper articles.

Claim 3: Kimura discloses additive such as a polyisocyanate compound added to form a substance having certain properties

Claims 49, 51: it would have been obvious to utilize vessels of any shape and structure. Product formed to be used as culture soil or as fertilizer does not structurally

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differentiate the present invention over the cited prior art.

5) Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Nishimura (JP 7-82686). Kimura is applied as above for claim 1, Kimura fails to disclose adding a fire retardant to waste paper pulp fibers to serve as incombustible material. Nishimura discloses adding a fire retardant to waste paper pulp fibers to serve as incombustible material (Abstract). It would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Kimura and Nishimura because such a combination would expand the applicability of the Kimura product as a flame resistant product.

#### Conclusion

 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Halpem/ Primary Examiner Art Unit 1791 Search Notes

Application	No

Applicant(s) 10/537,414

Examiner Mark Halpern YAMADA, MASAO Art Unit 1791

SEARCHED					
Class	Subclass	Date	Examiner		
162	261,4, 8,55	8/14/2008	мн		
241	46.17				
	259.1				
	261.3				
	28,29				

Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)			
	DATE	EXMR	
East Search (history attached)	8/14/2008	МН	
Inventor search conducted	8/14/2008	мн	